

REMARKS

Claims 1-5, 7-8, 19-27, 79, and 84-123 are currently pending. Claims 1-5, 7, 8, 19-27 and 79 have been amended to place the claims in better condition for allowance. Claims 6, 9-18, 28-29, 32, 33-49, 59-78, and 80-83 have been canceled without prejudice or disclaimer. Claims 30-31 and 50-58 have been withdrawn. Further, new claims 84-124 have been added. Support for these amendments can be found on at least pages 8-10, 16, 21-26, 28-29, and 32. Applicants respectfully submit that no new matter has been added by way of this amendment.

In the Office Action dated September 30, 2003, the Office set forth the following rejections:

- (i) claims 1, 2, 4, 5, 19, and 23-26 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Murljadic (U.S. Patent No. 5,766,006) in view of Roggenkamp (U.S. Patent No. 4,448,307) and Knudson (U.S. Patent No. 3,936,936);
- (ii) claim 3 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Murljadic in view of Roggenkamp and Knudson, and further in view of Migurski et al. (U.S. Patent No. 5,964,065);
- (iii) claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Murljadic in view of Roggenkamp and Knudson, and further in view of Kutsch (U.S. Patent No. 6,149,895);
- (iv) claims 20-22 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Murljadic in view of Roggenkamp and Knudson, and further in view of Cornell (U.S. Patent No. 5,032,178);
- (v) claim 27 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Murljadic in view of Roggenkamp, Knudson and Kutsch, and further in view of Prencipe et al. (U.S. Patent No. 5,698,182);
- (vi) claims 40-43, 45, 46, 69-75, 82, and 83 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell in view of Nikodem (U.S. Patent No. 5,813,854) and Kutsch;
- (vii) claims 44 and 47 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell in view of Nikodem and Kutsch, and further in view of Yarborough (U.S. Patent No. 5,713,738);
- (viii) claims 48 and 59-68 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell in view of Nikodem and Kutsch, and further in view of Kutsch and Pellico (U.S. Patent No. 5,928,628);

(ix) claim 49 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell in view of Nikodem and Kutsch, and further in view of Murljadic;

(x) claim 28 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell in view of Nikodem and Kutsch, and further in view of Prencipe et al.;

(xi) claim 29 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell, in view of Nikodem, Kutsch and Yarborough, and further in view of Pellico;

(xii) claims 76-78 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell, in view of Nikodem and Kutsch, and further in view of Tarver (U.S. Patent No. 6,030,222);

(xiii) claims 79-81 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cornell, in view of Nikodem, Kutsch, and Knudson;

(xiv) claims 40, 42, 44, and 47 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Montgomery et al. (U.S. Patent No. 6,162,055) (hereinafter “Montgomery ‘055”);

(xv) claims 41, 43, 48, and 59-83 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Montgomery ‘055, Montgomery et al. (U.S. Patent No. 6,343,933) (hereinafter “Montgomery ‘933”), or Cipolla (U.S. Patent No. 6,416,319);

(xvi) claims 45 and 46 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Montgomery ‘055, Montgomery ‘933, or Cipolla, and further in view of Kutsch;

(xvii) claim 49 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Montgomery ‘055, Montgomery ‘933, or Cipolla, and further in view of Murljadic;

(xviii) claims 40-48 and 59-83 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-21 of Cipolla in view of Kutsch; and

(ix) claim 49 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over claims 1-21 of Cipolla in view of Murljadic.

These rejections are respectfully traversed. Reconsideration of these rejections is hereby requested.

Applicants incorporate by reference all of the arguments set forth in the June 25, 2003 Amendment and Response to the August 15, 2002 Final Office Action. Applicants further respond to the Office’s objections as follows:

I. Rejections under 35 U.S.C. § 103(a)

As set forth above, Claims 1-5, 7, 8, 19-29, 40-49, and 59-83 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of various combinations of 12 separate references. These rejections are respectfully traversed because the subject-matter of these claims are not disclosed in the prior art, and there is no suggestion in the prior art to combine these references.

The present invention satisfies the existing need for a method of light-activated, tooth whitening, which can simultaneously whiten the teeth of more than one client at a time. Further, the present inventions provides dental professionals with a method that will consistently provide good tooth whitening results to a plurality of clients using a limited economical number of dental professionals. By limiting the number of dental professionals used during a light-activated, tooth whitening procedure, this method also cuts the costs associated with providing this procedure.

Specifically, the present invention discloses two methods of tooth whitening. First, claim 1, as amended, recites a method of providing light-activated, tooth whitening services to a plurality of clients by one dental professional comprising a light-activated, tooth whitening module containing at least two light-activated, tooth whitening workstations, assigning each client to a workstation, and having the dental professional administer light-activated, tooth whitening services to each client, wherein at least a portion of the light-activated, tooth whitening procedure is provided simultaneously.

Second, claim 79, as amended, recites a method of providing light-activated, tooth whitening services to a plurality of clients by one dental professional comprising a light-activated, tooth whitening module containing at least two light-activated, tooth whitening workstations, assigning each client to a workstation, and having the dental professional administer light-activated, tooth whitening services to each client, wherein the light-activated tooth whitening services comprises steps: 1.) of applying a whitening gel to all the cosmetically visible teeth of the client, 2.) applying the light to all the teeth for a fixed period of time, and 3.) repeating steps “1” and “2” two to five times.

In contrast, Murljadic discloses a method for reliably determining tooth shade. Specifically, Murljadic suggests a method for determining the shade of a tooth by providing a shade analyzer system, which determines the shade of a patient’s tooth using an intraoral camera connected to a shade analyzer subsystem, such as a digital video processor and a color display monitor. Murljadic only mentions tooth whitening as *a single step in a multi-step method* for reliably determining the shade of a tooth before and after the patient’s teeth

are cosmetically whitened. No procedures or specific methods for tooth whitening are disclosed or suggested.

Murljadic also does not disclose or suggest at least two light-activated tooth whitening workstations. Nor does Murljadic teach servicing two clients simultaneously in these workstations. Thus, because Murljadic does not disclose a method of providing light-activated, tooth whitening services to a plurality of clients by one dental professional, wherein at least a portion of the services are provided simultaneously, it does not disclose the subject matter of amended claims 1 and 79.

Roggenkamp also does not disclose the subject-matter of amended claims 1 and 79. Rather, Roggenkamp discloses a multi-compartmented container appropriate for storing dental burs or other rod-like dental tools. (See, e.g., column 2, lines 23-30 and claims 1-12). Roggenkamp neither mentions tooth whitening in any form, nor does it teach that dentists simultaneously provide treatment to more than one patient at a time in separate workstations. In fact, Applicants respectfully submit that the exact language in the patent is “practically simultaneously.” (Column 1, lines 26-27). Roggenkamp suggests that the dentist treat one patient with the items in the container and then move onto the next patient with the container after completing treatment of the first. Roggenkamp does not teach or suggest that a dentist utilize more than one fully equipped, light-activated, tooth whitening workstation. Therefore, because Roggenkamp does not teach or suggest methods of providing light-activated, tooth whitening procedures to a plurality of clients wherein at least a portion of the services are provided simultaneously, Roggenkamp does not disclose the subject matter of the claimed invention.

Likewise, Knudson does not disclose the subject matter of the claimed invention as Knudson discloses a design for a dental clinic. Specifically, Knudson discloses a dental clinic layout in which the dentist’s operatory is centrally divided by an equipment containing wall. Patient chairs are placed back to back with the equipment wall between them and both sections of the operatory are adjacent to a support area, which contains a clean-up section, a laboratory section, and a dark room. This dental clinic layout allows a dentist to efficiently move from patient to patient.

The Office argues that Knudson teaches that a dentist will utilize different workstations and work on a second patient during the wait time of the method being performed on the first patient. Applicants respectfully submit that its application discloses a method in which a plurality of patients can receive light-activated, tooth whitening services simultaneously. Knudson does not disclose using light-activated, tooth whitening services.

As such, Knudson does not teach or suggest any specific methods of light-activated, tooth whitening, and especially does not teach or suggest methods of providing light-activated, tooth whitening services to a plurality of clients wherein at least a portion of the services are provided simultaneously, as disclosed in amended claims 1 and 79.

Migurski also does not disclose the subject-matter of amended claims 1 and 79. Instead, Migurski discloses an advanced mobile surgical suite system that provides life-saving and stabilizing treatment to trauma victims at the scene of a disaster or accident. Migurski does not so much as mention light-activated, tooth whitening services, let alone a method for providing light-activated, tooth-whitening services to a plurality of clients, wherein at least a portion of the services are provided simultaneously. Consequently, Migurski does not suggest or teach the subject-matter of the claimed invention.

Similarly, Kutsch does not disclose the subject matter of the claimed invention. In fact, Applicants respectfully submit that Kutsch teaches away from the subject matter of Applicants' claimed invention. Kutsch teaches a tooth whitening composition and method that requires the treatment of each tooth separately. (See, e.g., column 9, lines 21-29). In contrast, Applicants claim a method of administering light-activated, tooth whitening services that comprises applying a whitening gel, and exposing light to **all** of a client's cosmetically visible teeth. In addition, unlike Applicants' claimed invention, Kutsch does not teach a tooth whitening method that utilizes at least two light-activated tooth whitening workstations and can provide simultaneous tooth whitening services to a plurality of clients. Hence, Kutsch teaches away from amended claims 1 and 79.

Cornell is another piece of prior art that does not teach or suggest the subject matter claimed in amended claims 1 and 79. Cornell discloses tooth whitening compositions and the use of a dental curing light for 5 to 15 minutes. Cornell does not teach or suggest a method for providing light-activated, tooth whitening services to a plurality of clients, wherein at least a portion of the services are provided simultaneously. Accordingly, Cornell does not teach or suggest the methods disclosed in the Pending Application.

Likewise, Prencipe does not teach or suggest the methods disclosed in the claims of the Pending Application. Rather, Prencipe is directed to a method of inhibiting dental calculus. Prencipe merely discloses specific calcium alumina compounds having calcium peroxide with, optionally, a plethora of additives, which optionally include flavoring agents. Prencipe, neither alone nor in combination with the references already discussed, teaches or suggests the combination of flavoring agents in a composition and a method of providing

light-activated, tooth whitening services to a plurality of clients wherein at least a portion of the tooth whitening procedure is provided to each client simultaneously.

Nikodem also does not teach or suggest the claimed subject matter. Nikodem is directed to a device for quickly and efficiently bonding braces to a patient's teeth. The device of Nikodem bonds braces to a patient's teeth using light to cure the adhesives that adhere the braces to the tooth surfaces. Nikodem does not teach, enable, disclose or suggest methods of providing light-activated, tooth-whitening services to more than one client.

Similarly, Yarborough does not teach or suggest methods of simultaneously providing tooth whitening services to a plurality of clients. Yarborough is merely directed to a method of whitening teeth. Specifically, Yarborough discloses isolating the gums from the chemical bleaching compounds, preferably using wax-like strips applied to the gums. Nowhere in the Yarborough patent are the methods of amended claims 1 and 79 disclosed.

Pellico also does not disclose the methods claimed in amended claims 1 and 79. Pellico is directed to a two-component dental bleaching system wherein the components are admixed and applied to the teeth from a dental bleaching tray, which is worn by the patient at night while the patient sleeps. Pellico does not teach or suggest methods of providing light-activated, tooth whitening services to a plurality of clients simultaneously. Thus, Pellico does not disclose the subject matter of the Pending Application.

Finally, Tarver does not teach or suggest the methods disclosed in amended claims 1 and 79. Tarver discloses a whitening composition that "comprises a complementary dye color which, when used to treat off-white and yellowish teeth, acts to mask yellowish and off-white colors of the teeth so that whiter teeth are perceived." (Column 4, lines 26-31). Thus, Tarver does not suggest a method of actually whitening a patient's teeth. Rather, Tarver teaches a method of masking a tooth's discoloration. Tarver also does not teach or suggest a method of providing light-activated, tooth whitening services to a plurality of clients wherein at least a portion of the tooth whitening procedure is provided to each client simultaneously.

None of the cited references, alone or in combination, teach the method as recited in amended claim 1. Particularly, the cited references do not teach or suggest the combination of a method of providing light-activated, tooth whitening services to a plurality of clients wherein at least a portion of the tooth whitening procedure is provided to each client simultaneously. Thus, all of the elements recited in amended claim 1 cannot be found in the cited art, either alone or in combination. Applicants respectfully submit that amended claim 1 is patentable over the cited art.

Claims 2-5, 7-8, and 19-27 depend from independent, amended claim 1. Therefore, the patentability of amended claim 1 over the prior art establishes the patentability of claims 2-5, 7-8, and 19-27. Further, none of the references teach or suggest the limitations recited in claims 2-5, 7-8, and 19-27, either alone or in combination.

None of the cited references, alone or in combination, teach the method as recited in amended claim 79. Particularly, the cited references do not teach or suggest the combination of a method of providing light-activated, tooth whitening services to a plurality of clients, wherein the light-activated, tooth whitening services comprises steps: 1.) of applying a whitening gel to all the cosmetically visible teeth of the client, 2.) applying the light to all the teeth for a fixed period of time, and 3.) repeating steps “1” and “2” two to five times. Thus, all of the elements recited in amended claim 79 cannot be found in the cited art, either alone or in combination. Applicants respectfully submit that amended claim 79 is patentable over the cited art.

Claims 84-124 depend from independent amended claim 79. Therefore, the patentability of amended claim 79 over the prior art establishes the patentability of claims 84-124. Further, none of the references teach or suggest the limitations recited in claims 84-124, either alone or in combination.

In light of the arguments listed above, Applicants respectfully state that claims 1, 2, 4, 5, 19, and 23-26 are patentable over Murljadic in view of Roggenkamp and Knudson.

As set forth herein, independent claim 1 has been distinguished from Murljadic, Roggenkamp, and Knudson. Claim 3 depends on claim 1 and Migurski fails to submit the missing elements of claim 1. Consequently, Applicants respectfully submit that claim 3 is patentable.

As set forth herein, independent claim 1 has been distinguished from Murljadic, Roggenkamp, and Knudson. Claims 7 and 8 depend on claim 1 and Kutsch fails to submit the missing elements of claim 1. Consequently, Applicants respectfully submit that claims 7 and 8 are patentable.

As set forth herein, independent claim 1 has been distinguished from Murljadic, Roggenkamp, and Knudson. Claims 20-22 depend on claim 1 and Cornell fails to submit the missing elements of claim 1. Consequently, Applicants respectfully submit that claims 20-22 are patentable.

As set forth herein, independent claim 1 has been distinguished from Murljadic, Roggenkamp, and Knudson. Claim 27 depends on claim 1 and Prencipe fails to submit the

missing elements of claim 1. Consequently, Applicants respectfully submit that claim 27 is patentable.

In light of the arguments listed above, Applicants respectfully state that claim 79 has been distinguished from Cornell, Nikodem, Kutsch, and Pellico. Claims 40-43, 45, 46, 69-75, 82, and 83 have been canceled, but essentially rewritten as dependent claims 84-86 and 88-112, which depend from claim 79. Consequently, Applicants respectfully submit that new claims 84-86 and 88-112 are patentable.

As set forth herein, independent claim 79 has been distinguished from Cornell, Nikodem, Kutsch, and Pellico. Claims 44 and 47 have been canceled, but essentially rewritten as dependent claims 90 and 91, which depend from claim 79. Furthermore, Yarborough fails to submit the missing elements of claim 79. Consequently, Applicants respectfully submit that new claims 90 and 91 are patentable.

As set forth herein, independent claim 79 has been distinguished from Cornell, Nikodem, Kutsch, and Pellico. Claim 48 and 59-68 have been canceled, but essentially rewritten as a dependent claims 92-102, which depend from claim 79. Consequently, Applicants respectfully submit that new claims 92-102 are patentable.

As set forth herein, independent claim 79 has been distinguished from Cornell, Nikodem, Kutsch, and Pellico. Claim 49 has been canceled, but essentially rewritten as a dependent claim 94, which depends from claim 79. Furthermore, Murljadic fails to submit the missing elements of claim 79. Consequently, Applicants respectfully submit that new claim 94 patentable.

As set forth herein, independent claim 1 has been distinguished from Murljadic, Roggenkamp, and Knudson. Claim 28 depends on claim 1, and Cornell, Nikodem, Kutsch, and Prencipe fail to submit the missing elements of claim 1. Consequently, Applicants respectfully submit that claim 28 is patentable.

As set forth herein, independent claim 1 has been distinguished from Murljadic, Roggenkamp, and Knudson. Claim 29 depends on claim 1, and Cornell, Nikodem, Kutsch, Yarborough, and Pellico fail to submit the missing elements of claim 1. Consequently, Applicants respectfully submit that claim 29 is patentable.

As set forth herein, independent claim 79 has been distinguished from Cornell, Nikodem, Kutsch, and Pellico. Claims 76-78 have been canceled, but essentially rewritten as dependent claims 110-112, which depend from claim 79. Furthermore, Tarver fails to submit the missing elements of claim 79. Consequently, Applicants respectfully submit that new claims 110-112 are patentable.

As set forth herein, independent claim 79 has been distinguished from Cornell, Nikodem, Kutsch, and Pellico. Claims 80 and 81 have been canceled, but essentially rewritten as dependent claim 86, which depends from claim 79. Furthermore, Knudson fails to submit the missing elements of claim 79. Consequently, Applicants respectfully submit that new claim 86 is patentable.

II. Rejections under 35 U.S.C. § 102(e)

The Office rejected claims 40, 42, 44, and 47 under 35 U.S.C. § 102(e) as allegedly anticipated by Montgomery '055. However, this argument is now moot as Applicants have canceled these claims without prejudice or disclaimer to expedite prosecution. Applicants reserve its rights to pursue this subject matter in this or a related application.

Nevertheless, it should be noted that Montgomery does not anticipate claims 40, 42, 44, and 47. Montgomery '055 does not disclose the elements of these claims as it does not disclose a method of providing light-activated, tooth whitening services to a plurality of clients by one dental professional comprising a light-activated, tooth whitening module containing at least two light-activated, tooth whitening workstations, assigning each client to a workstation, and having the dental professional administer light-activated, tooth whitening services to each client, wherein at least a portion of the light-activated, tooth whitening procedure is provided simultaneously. Because Montgomery '055 does not disclose every element of these claims, it cannot anticipate these claims.

III. Rejections under 35 U.S.C. § 103(a)

Claims 41, 43, 48, and 59-83 were rejected by the Office under 35 U.S.C. § 103(a) as being obvious over Montgomery '055, Montgomery '933, or Cipolla. However, the Office explained that because the above "reference[s] ha[ve] a common inventor ...[they] constitute prior art only under 35 U.S.C. § 102(e)." (September 30, 2003 Office Action, Page 10).

Applicants have canceled claims 41, 43, 48, 59-78, and 80-83; therefore, this rejection is now moot with respect to these claims. Although these canceled claims have essentially been rewritten as dependent claims of independent claim 79, these claims are allowable based on the argument set forth below and Applicants' following statement of ownership.

Applicants respectfully submit that they overcome this rejection because 35 U.S.C. § 103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the

subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Because Britesmile, Inc., owns all three of the patents cited by the Office, and did own all three patents at the time this invention was made, these patents cannot preclude patentability of the subject matter of claim 79 and its dependent claims. Thus, Applicants respectfully request that the Office withdraw this rejection.

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STATEMENT OF COMMON OWNERSHIP

U.S. Patent No. 6,162,055, U.S. Patent No. 6,343,933, and U.S. Patent No. 6,416,319 were, at the time the invention of Application No. 09/483,526 was made, owned by Britesmile, Inc.
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In light of the arguments listed above, Applicants respectfully state that claims 41, 43, 48, and 59-83, which have essentially been rewritten as dependent claims 92-102, are patentable over Montgomery '055, Montgomery '933 and Cipolla.

Similarly, in light of the foregoing arguments, Applicants respectfully submit that claims 45 and 46, which have essentially been rewritten as dependent claims 89 and 90, are patentable over Montgomery '055, Montgomery '933, Cipolla, and in further view of Kutsch.

In addition, Applicants respectfully submit that in light of the above arguments, claim 49, which has essentially been rewritten as dependent claim 94, is patentable over Montgomery '055, Montgomery '933 or Cipolla, and further in view of Murljagic.

IV. Rejections under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Office rejected claims 40-48 and 59-83 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-21 of Cipolla in view of Kutsch. Applicants have canceled claims 40-48, 59-78, and 80-83; however, these claims have essentially been rewritten as dependent claims 84-86 and 88-112.

Applicants respectfully traverse this rejection and request withdrawal of the same. Claim 79 and new claims 84-86 and 88-112 are patentable over Cipolla in view of Kutsch as Applicants have taken the Office's advice and submitted with this Amendment a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). Consequently, Applicants respectfully ask that the Office withdraw this rejection.

In light of the arguments listed above, Applicants respectfully state that claims 40-48 and 59-83, which have essentially been rewritten as dependent claims 84-86 and 88-112, are patentable over claims 1-21 of Cipolla in view of Kutsch.

In addition, Applicants respectfully submit that in light of the above arguments and the filing of the terminal disclaimer, claim 49, which has essentially been rewritten as dependent claim 94, is patentable over claims 1-21 of Cipolla in view of Murljadic.

CONCLUSION

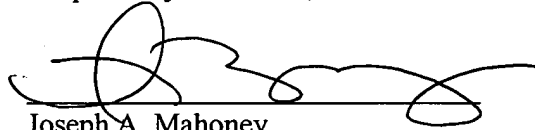
It is respectfully submitted that in view of the foregoing Amendment and Remarks, all of the objections and rejections in the Office Action dated September 30, 2003, have been overcome and should be withdrawn. Accordingly, reconsideration and withdrawal of the outstanding rejections and allowance of claims 1-5, 7-8, 19-27, 79, and 84-123 is respectfully solicited and the Office is respectfully requested to pass this application to issue.

None of Applicant's amendments or cancellations are to be construed as dedicating any such subject matter to the public, and Applicant reserves all rights to pursue any such subject matter in this or a related patent application.

If, in the opinion of the Office, a telephone conference would expedite the prosecution of the subject application, the Office is invited to call the undersigned attorney.

In addition, if there are any additional fees due in connection with the filing of this response, please charge these additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 13-0019.

Respectfully submitted,



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